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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,451	02/22/2005	Veli Kasma	METSO-21	1379

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/507,451

Applicant(s)

KASMA ET AL.

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 8-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-27-05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Specification***

The amendments in response to the Title Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

#### ***Claim Objections***

The amendments in response to the Claim Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

All prior 35 USC 112 and prior art rejections are withdrawn in view of claim amendments and cancellations.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 10,11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 8 is vague and indefinite because it is unclear if the 10.1-99.5 wt% refers only to the inorganic material or the mixture.
- Claims 10,11 are vague and indefinite because the relative term "hard" does not convey the intended hardness of the metals, it is not defined by the specification, and the relativity of metal hardness prevents understanding by one of ordinary skill given the large range of commercial metals of varying hardnesses available on the market.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lobel WO01/14607 (US6556804 is used in lieu of a certified translation given priority claims; page/line citations refer to US patent) in view of Takagi US 5474871 and further in view of Rinehart et al US 5827608.

Lobel teaches applying dry toner particles to a continuous web substrate following direction P1 (Fig. 3), and having transfer means opposing both sides of the web, each carrying particles of a given polarity opposite the other to create an electrostatic field which results in adherence of particles to opposite sides of the web essentially simultaneously (fig. 28; col. 2, 1-30). Particles are pre-charged prior to being applied to the web. The particle coated web is then thermally fixed (col. 9, 38-51). Cooperating electrodes provide charge to particles being applied. Wire-shaped corotron (corona) wires are described, e.g. col 5, 64- col 6, 29, per claim 14. Toner composition is not limited. Toner composition and heat-treating through a nip of heated rollers are not disclosed.

Takagi teaches toner particles suitable for double-sided copying on a web, the toner comprising 30-70 wt% magnetic oxide, a polymeric fixing/ binder resin and inorganic powder, e.g. silica to form a toner which provides wear and smudge resistant coatings. The composition overlaps that of claims 8, 17-18. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the compositions disclosed by the reference were selected because overlapping ranges have been

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held to be a prima facie case of obviousness, see *In re Wortheim* 191 USPQ 90. Heat-treating through a nip of heated rollers is not disclosed.

Rinehart teaches electrostatically applying powder to a web, and then fixing and fusing the particles thereto by running the coated web through a nip of at least one heated metal roller 18,20 sufficient to fuse the particles without distortion; e.g. 182 and 191 degrees C in ex. 6-10 which is within the range of claim 12.

Since both Rinehart and Lobel fix polymer-bearing powder compositions to a web by heat-fixing, it would have been obvious to substitute one known thermal heat fixing means for another, i.e. the IR heating for the heated roller nip, because both are disclosed for similar particle fixing functions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Lobel by incorporating the toner composition of Takagi to provide wear and smudge resistance, and further treating the coated surfaces using a heated roller nip as taught by Rinehart to fuse and fix the particle layer to the web having wear and smudge resistance.

### ***Response to Arguments***

Applicants remarks have been considered. Arguments are directed to the rejections of the previous Office Action, which are withdrawn in view of amendment, and hence arguments are moot.

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5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

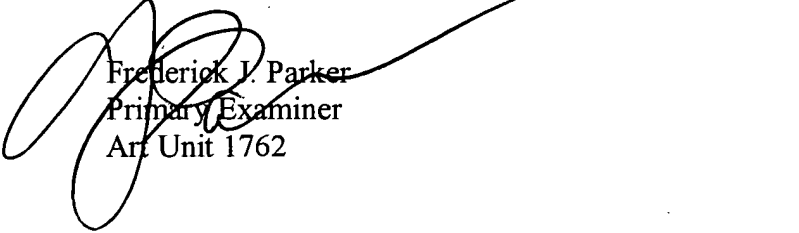
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp